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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/063,534	05/02/2002	Dan L. Eaton	P3230R1C001-168	9569
30313	7590	06/03/2004	EXAMINER	
KNOBBE, MARTENS, OLSON & BEAR, LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			SEHARASEYON, JEGATHEESAN	
			ART UNIT	PAPER NUMBER
			1647	
DATE MAILED: 06/03/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/063,534

**Applicant(s)**

EATON ET AL.

**Examiner**

Jegatheesan Seharaseyon

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/10/02.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1-6 are pending and under consideration. The claims are drawn to antibodies that bind to PRO831 polypeptide of SEQ ID NO: 30.

### ***Specification***

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

3. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.823(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.823 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures. Applicant must comply with the requirements of the sequence rules (37 CFR 1.823 - 1.825). **Applicant is required to provide a paper copy of the CRF when filing the response to this Office Action.**

### ***Information Disclosure Statement***

4. The information disclosure statement, filed 9/10/2002, has been considered. The BLAST results demonstrate that applicants are aware of nucleic acids with identity/homology to the one claimed herein. However, as the BLAST results do not give sufficient identifying information, the Examiner cannot determine if said sequences constitute prior art.

***Priority Determination***

5. The claimed protein has no utility, see rejection below. Accordingly, priority is set at the instant filing date, 5/2/02.

Should the applicant disagree with the examiners factual determination above, it is incumbent upon the applicant to provide the serial number and specific page number(s) of any parent application filed prior to the date recited above which specifically supports the particular claim limitation for each and every claim limitation in all the pending claims which applicant considers to have been in possession of, and fully enabled for, prior to that date.

***Rejections under 35 U.S.C. §101 and §112:***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-6 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific, substantial and credible asserted utility or a well established utility.

The claims are directed to antibodies that bind the protein of SEQ ID NO: 30. The specification contains numerous asserted utilities for the claimed antibodies, including use to identify molecules that bind to PRO831 (including agonists and antagonists), diagnostic assays, affinity purification, and for the therapeutic purposes. The utilities that pertain solely to nucleic acids (e.g. hybridization, chromosome and gene mapping, anti-sense) would not convey to the encoded protein or the antibody. With respect to

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the remaining utilities, none of these asserted utilities is specific for the disclosed PRO831 protein, as each of the aforementioned utilities could be asserted for any naturally occurring protein, and further, as none of the asserted utilities requires any feature or activity that is specific to the disclosed PRO831.

The specification asserts that PRO831 is an unspecified secreted transmembrane polypeptide. However, this family of proteins does not possess a common utility, but rather the proteins that can be broadly classified and have different activities, that confer different uses on them. Accordingly, the mere identification of a protein as belonging to a family, while indicative of evolutionary relatedness, is not indicative of function, nor by extension, of utility. The structure of the putative PRO831 peptide is briefly discussed in Figure 30, as having a signal peptide, corresponding to about amino acids 1-15, and growth factor and cytokine receptor family sequence, corresponding to about amino acids 3-18. However, there is no functional characteristic associated with these motifs, hence the mere observation that they exist is not probative of function or utility. Further, there is no disclosure that the protein is expected to be a transmembrane protein, nor has any extracellular domain. There is no biological activity, expression pattern, phenotype, disease or condition, ligand, binding partner, any other specific feature that is disclosed as being associated with PRO831. Without any information as to the specific properties of PRO831, the mere identification of such as having homology to a secreted transmembrane protein is not sufficient to impart any particular utility to the claimed antibodies.

The polynucleotide (cDNA) is disclosed to be more highly expressed in kidney tumor compared to the normal kidney based on the PCR amplification of cDNA libraries (see page 141). Similarly, it is also disclosed that the polynucleotide is also more highly expressed in normal lung compared to lung tumor (see page 141). Thus, the specification asserts that the polynucleotide encoding PRO831 polypeptide being more highly expressed in kidney tumor vs. normal kidney and also normal lung vs. lung tumor renders the molecule useful for the diagnosis, as well as therapeutically as a target for the treatment (see page 140). There is no supporting evidence to indicate that the polypeptide encoded by the polynucleotide of the instant invention is more highly expressed in some normal tissues and tumor tissues compared to their tumor and normal tissue counterparts, and as such one of skilled in the art would conclude that it is not supported by a substantial asserted utility or a well-established utility. Although, the specification claims that the polynucleotide is more highly expressed in kidney tumor and normal lung, the specification does not teach what is the normal level of expression, does not indicate how high the expression level is compared to for example, normal kidney tumor or lung tumor; and does not provide a statistical correlation to the level of expression (for example, there is no indication of how many samples were compared to study the expression). Furthermore, if the tumor is malignant, the specification fails to describe the type or kind of tumor present in kidney and lung (for example, is it an adenocarcinoma or renal cell carcinoma etc.). Without knowing the identity of the tumor, one of skill in art cannot use the protein or antibodies for diagnosis or therapeutic purposes as asserted. The specification does not disclose a correlation between any

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specific disorder and the altered level or form of the claimed polypeptides. Also, the specification does not predict whether the polypeptides would have high or low expression in a specific, diseased tissue compared to the healthy tissue control. In addition, the specification does not teach or describe the function of this yet to identified polypeptide. With respect to the remaining utilities, none of these asserted utilities is specific for the disclosed PRO831 encoding polypeptides, as each of the aforementioned utilities could be asserted for any naturally occurring polypeptides, and further, as none of the asserted utilities requires any feature or activity that is specific to the disclosed PRO831 polypeptides. In addition, since the specification states that the DNA was amplified from the cDNA library from different human tumor and human normal tissue samples, there is no possibility for direct comparison of the expression between the normal and tumor tissues (see page 140).

Cancerous tissue is known to be aneuploid, that is, having an abnormal number of chromosomes (see Sen, 2000, Curr. Opin. Oncol. 12: 82-88). The data presented in the specification were not corrected for aneuploidy. A slight amplification of a gene does not necessarily mean overexpression in a tissue, but can merely be an indication that the cancer tissue is aneuploid. The preliminary data were not supported by analysis of mRNA or protein expression, for example. Also, the literature reports that it does not necessarily follow that an increase in gene copy number results in increased gene expression and increased polypeptide expression, such that the claimed polypeptides would be useful for diagnosis of cancer or as a drug target. This fact is documented by Pennica et al. (1998, PNAS USA 95:14717-14722). In addition, they

also observed that there was no correlation between *WISP-2* mRNA expression and colon tumors. Furthermore they disclose that:

“An analysis of *WISP-1* gene amplification and expression in human colon tumors showed a correlation between DNA amplification and overexpression, whereas overexpression of *WISP-3* RNA was seen in the absence of DNA amplification. In contrast, *WISP-2* DNA was amplified in the colon tumors, but its mRNA expression was significantly reduced in the majority of tumors compared with the expression in normal colonic mucosa from the same patient.”

See p. 14722, second paragraph of left column; pp. 14720-14721, “Amplification and Aberrant Expression of *WISPs* in Human Colon Tumors.” Therefore, data pertaining to PRO831 nucleic acids do not necessarily indicate any substantial utility regarding the claimed PRO831 polypeptides or the antibodies binding to the polypeptide. Thus, the data does not support the implicit assertion that the nucleotide encoding PRO831 can be used in cancer diagnosis or therapy. Significant further research would have been required of the skilled artisan to determine why PRO831 is more highly expressed in normal tissue compared to tumor tissue to the extent that it could be used as a cancer diagnostic, and thus the implicitly asserted utility is not substantial.

The instant application has failed to provide guidance as to how one of skill in the art could use the claimed invention in a way that constitutes a substantial utility. The proposed uses of the claimed invention are simply starting points for further research

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and investigation into potential practical uses of the claimed the polypeptides. "Congress intended that no patent be granted on a chemical compound whose sole 'utility' consists of its potential role as an object of use-testing." *Brenner v. Manson*, 148 USPQ: at 696.

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7a. Claims 1-6 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific, substantial and credible asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8a. Claim 1 states that the claimed antibody "binds" the protein of SEQ ID NO: 30, whereas dependent claim 6 states that the antibody "specifically binds". The term "specifically" in claim 6 is a relative term that renders the claim indefinite. The term "specifically" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be

reasonably apprised of the scope of the invention. Further, the antibodies would presumably be of no use if they did not bind to the protein of SEQ ID NO: 30 with specificity; therefore, it must be presumed that there is some level of specificity implicit in all the claims. As the difference between "binds" and "specifically binds" cannot be determined, the metes and bounds of all the claims are unclear. Change of "specifically" would be remedial, but then claim 6 would be duplicate of claim 1.

***Claim Rejections - 35 USC § 102***

Priority is set at the instant filing date, 5/2/2002, as no disclosure to which priority is claimed meets the requirements of 35 U.S.C 101 and 112, first paragraph.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9a Claims 1- 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Bergsma. et al. (U.S. Patent No: 6,001,963).

Amino acids 14-22 of SEQ ID NO: 2 described by Bergsma et al has 100% identity over amino acids 5-13 of SEQ ID NO: 30 of the instant invention (see Appendix A).

Therefore, antibody generated to this sequence will specifically bind to SEQ ID NO: 30 of the instant invention. In addition, Bergsma et al. also describe monoclonal antibodies, humanized antibodies, antibody fragments and labelled antibodies (columns 4 and 12-

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14). Therefore, claims 1-6 directed to antibodies are anticipated by Bergsma et al. (U.S. Patent No: 6,001,963).


10. No claim is allowed.

### **Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jegatheesan Seharaseyon whose telephone number is 571-272-0892. The examiner can normally be reached on M-F: 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on 571-272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**GARY KUNZ**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**

JS/05/04

<b>Notice to Comply</b>	<b>Application No.</b> 10/063 534	<b>Applicant(s)</b> E ATON ET AL	
	<b>Examiner</b> J. Scheraga	<b>Art Unit</b> 1647	

**NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS  
CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE  
DISCLOSURES**

Applicant must file the items indicated below within the time period set the Office action to which the Notice is attached to avoid abandonment under 35 U.S.C. § 133 (extensions of time may be obtained under the provisions of 37 CFR 1.136(a)).

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 C.F.R. 1.821 - 1.825 for the following reason(s):

- ☐ 1. This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicant's attention is directed to the final rulemaking notice published at 55 FR 18230 (May 1, 1990), and 1114 OG 29 (May 15, 1990). If the effective filing date is on or after July 1, 1998, see the final rulemaking notice published at 63 FR 29620 (June 1, 1998) and 1211 OG 82 (June 23, 1998).
- ☒ 2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 C.F.R. 1.821(c).
- ☐ 3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 C.F.R. 1.821(e).
- ☐ 4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 C.F.R. 1.822 and/or 1.823, as indicated on the attached copy of the marked -up "Raw Sequence Listing."
- ☐ 5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A Substitute computer readable form must be submitted as required by 37 C.F.R. 1.825(d).
- ☐ 6. The paper copy of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 C.F.R. 1.821(e).
- ☐ 7. Other:

**Applicant Must Provide:**

- ☐ An initial or substitute computer readable form (CRF) copy of the "Sequence Listing".
- ☒ An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification.
- ☒ A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d).

For questions regarding compliance to these requirements, please contact:

For Rules Interpretation, call (703) 308-4216 or (703) 308-2923

For CRF Submission Help, call (703) 308-4212 or 308-2923

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